REMARKS

Claims 1-11, 18-20 and 41-45 remain in the application. Claims 12-17 and 21-40 have been cancelled. Claims 1, 8, 9, 19, 41 and 43 have been amended. Claim 45 has been added.

The Amendments

Claims 1, 41 and 43 have been amended to specify that the removable and resealable adhesive (b) is removable and resealable in the presence of moisture from refrigerated or frozen food packaging environments. Support is found on page 2, lines 21-22.

Claims 1, 41 and 43 also have been amended to specify that the removable and resealable adhesive has a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. Support for this amendment is found on page 10, line 15.

Claim 8 has been amended to specify the adhesive is an acrylic based adhesive. Support is in original claim 8. Claim 9 now specifies the adhesive comprises a UV curable acrylic adhesive. Support for this amendment is found on page 17, lines 11-20.

Claim 19 has been amended to correct an obvious typing error.

New claim 45 is dependent from claim 1 and specifies that the removable and resealable adhesive (b) is removable and resealable at temperatures within the range of about 10°C to about -30°C. Support for this amendment is found on page 10, lines 10-12.

Claims 12-17 and 21-24, and claims 25-40, directed to a non-elected invention, have been cancelled.

Entry of all of the above amendments is requested.

The Rejection

I. Claims 1-11, 21, 23, 41 and 43 have been rejected under 35 U.S.C. §102(b) as being anticipated by MacGregor et al. (US 4,846,504).

The Examiner maintains that MacGregor teaches a label assembly comprising a backing tape 12 (carrier) with a release layer, barring a series of labels (adhesive articles). Each of the labels is formed of a base label 20, a promotional label 22 and an outer label 24 (see Fig. 1). The Examiner further notes that the base label is secured to the backing tape with a permanent pressure sensitive adhesive; the promotional label is slightly secured to the base label by a transparent, non-tacky, peelable adhesive (removable); and the outer label is secured to the base layer by a permanent pressure sensitive, water-soluble adhesive. The Examiner further contends that MacGregor teaches the promotional label (substrate) is formed of a water resistant material, and the peeling force of the removable or seelable adhesive covering the promotional label is approximately 0.7 lbs/in. or 0.9 lbs/in. (see column 3, lines 55-65); column 4, lines 4-7, which reads on the instantly claimed range. Moreover, the Examiner contends that MacGregor teaches the "removable and resealable adhesive" to be acrylic based or rubber-based hot melt pressure sensitive adhesive (see column 3, line 66; column 4, lines 4-7, 42-47). Reconsideration and withdrawal of this rejection is requested since MacGregor does not anticipate the adhesive article as presently claimed. Contrary to the Examiner's allegation, page 3 of the final rejection, MacGregor does not teach that the acrylic based or rubber based hot melt pressure sensitive adhesive described in column 3, line 66 and column 4, lines 4-7 and 42-47 to be "resealable adhesives". The rubber based adhesive mentioned in column 3, line 66 is indicated by MacGregor as being a "permanent adhesive" with a peel force of approximately 4.5 lbs; the acrylic-based adhesive mentioned in column 4, lines 1-4 and 9-11 are identified as permanent adhesives. Removable adhesives are described by MacGregor in column 4, lines 4-7 and 42-47. None of these adhesives are described by MacGregor as being "reseable" under any conditions.

Applicant respectfully submits that MacGregor neither teaches nor suggests that the removable adhesive utilized in his adhesive articles is resealable. The only mention of a resealable adhesive is found in MacGregor's description of the characteristics of "permanent" and "removable" pressure sensitive adhesives found in column 3, lines 46-65. MacGregor does not teach or suggest that the adhesive utilized to secure the promotional label 22 to the base label portion 20. The object of MacGregor's secure label assembly is to allow the purchaser of a product to run water over the label to dissolve the permanent adhesive on the outer surface of the label assembly thereby revealing the promotional material which is lightly adhered to a backing strip by a transparent non-tacky adhesive. When the promotional label is thus exposed, it can be removed from the base label 20 to which it is lightly adhered (column 3, lines 33-45). There is no teaching or suggestion in MacGregor that after the promotional material is removed, it may be reattached (resealed) to the base layer. Since the objective of the label assembly described by MacGregor is to provide a promotional material (such as a coupon or prize to be reedemed or a game piece to be utilized), it is understandable why MacGregor doesn't teach the use of a "resealable" adhesive. Ease of removability is what is taught by MacGregor as being important.

Moreover, it is respectfully submitted that the Examiner's suggestion on page 3, first full paragraph, that the peel forces described by MacGregor read on the instantly claimed range is in error. The values specified in the claim are Moist Loop Test results which are not the same as the peel forces mentioned by MacGregor. The Moist Loop Test is described in the present application on pages 3 and 4, and this test is performed in a cabinet environment with varying test plate temperatures to similate various moisture condensation conditions. Thus, the test measures adhesion in the presence of moisture at low temperatures such as temperatures found in refrigerators and freezers. In view of the clear differences in the test conditions, there is no basis for the Examiner's suggestion that the peeling forces described by MacGregor read on the Moist Loop Test results of the present claims.

In view of the above, reconsideration and withdrawal of the rejection of claims 1-11, 41 and 43 being anticipated by MacGregor is requested.

II. Claims 1-3, 8-11, 18-24, 41-44 have been rejected under 35 U.S.C. §102(b) as being anticipated by Sorensen et al. (US 4,771,891).

The Examiner contends that Sorensen teaches a roll of backing strip with a release layer, and labels (substrates) adhering to the release layer (column 2, lines 36-40; column 5, lines 17-25). The adhesive is applied on selected areas of the label including a full coverage area 18 where permanent adhesion is desired, and a relatively lighter pattern coverage in the area 22 where the label is releasable or removable. The Examiner also notes that Sorensen teaches that the adhesive may be an acrylic-based, rubber-based or hot melt pressure sensitive adhesive, and the adhesive has a peeling force of approximately 0.7 bs/in and 0.9 lbs/in. which, according to the Examiner, appears to read on the instantly claimed range. The Examiner also contends that since Sorensen teaches a removable and resealable adhesive which include the same chemical components as disclosed in the instant specification, Sorensen's adhesive would inherently have the same properties, such as the peeling force and cohesive strength.

Reconsideration and withdrawal of this rejection is respectfully requested in view of the above amendments to the claims. All of the claims now specify that the adhesive article of the invention comprises (a) a moisture resistant substrate having a first and second surface, (b) a removable and resealable adhesive covering at least a portion of the first surface of the substrate, wherein the removable and resealable adhesive is removable and resealable in the presence of moisture from refrigerated or frozen food packaging environments, and the adhesive has a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. Although Sorensen describes labels utilizing removable and resealable adhesives, there is no teaching or suggestion of the use of such ashesive articles in refrigerated or frozen food packaging environments, nor is there any teaching or suggestion of adhesives which are resealable in the presence of moisture at these low

temperatures. In addition, Sorensen neither teaches nor suggests removable and resealable adhesives characterized as having a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. As mentioned above, Sorensen discusses the peeling force of pressure sensitive adhesives and suggests that removable adhesives have peeling forces of about 0.7 lbs/in. and 0.9 lbs/in. The claims of the present application require adhesives having a Moist Loop Test result (which is different from peeling force measurements) of at least about 0.8 N/25mm at a test plate temperature of 5°C.

Although Sorensen generally describes the use of acrylic-based, rubber-based or hot melt pressure sensitive adhesives, there is no further discussion of the adhesives and no examples of specific adhesives utilized as the removable adhesives in Sorensen. The rejection based upon the Examiner's contention that Sorensen's adhesives would inherently have the same properties, such as Moist Loop Test results, should be withdrawn. There is no adhesive disclosed by Sorensen which inherently has the same Moist Loop Test result as presently claimed. Moreover, even though some of the adhesives included within the broad categories of acrylic-based, rubber-based or hot melt pressure sensitive adhesives mentioned in Sorensen may exhibit a Moist Loop Test result within the claimed range, such possibilities or probabilities do not support a rejection based on inherency.

The Examiner has not relied upon any discussion in Sorensen that would suggest these Moist Loop Test results are inherent. The Examiner's position is based solely on his interpretation of Sorensen after reading the present application. As noted in the recent Hunter Douglas Inc. v. Comfortex Corp., 49 USPQ 2d, 1785, 1789 (Fed. Cir. 1998).

> To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

> recognized by persons of ordinary skill.... Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the question function, it seems to be well settled that the disclosure should be regarded as sufficient. Citing Continental Can Co. USA Inc. v. Monsanto Co., 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991)

The Examiner is requested to reconsider and withdraw the rejection of the claims as obvious over Sorensen because there is no extrinsic evidence that the adhesives of the Sorensen patent are always characterized by a Moist Loop Test result of at least about 0.8 N/25 mm at a test plate temperature of 5°C or that the removable adhesive is removable and resealable in the presence of moisture at refrigerated and frozen food packaging environments.

In addition, claims 18-20, 42 and 44 specify that the adhesive article also further comprises (c) at least one permanent adhesive covering a second portion of the first surface of the substrate. Rejection of these claims should be withdrawn because Sorensen neither teaches nor suggests an article containing both a removable adhesive and a permanent adhesive on different portions of the same surface of a substrate. Sorensen teaches the use of an adhesive, which is either a permanent adhesive (column 4, lines 38-39) or a removable or resealable adhesive (column 4, line 51). The adhesive is applied in variable patterns on different areas of the labels to provide different adhesive strengths. Since there is no teaching or suggestion of utilizing the combination of a permanent adhesive and a removable adhesive, the rejection of at least claims 18-20, 42 and 44 claims as anticipated by Sorensen should be withdrawn. The claims are not anticipated.

III. Claims 1-5, 9-10, 12-18 and 21-22 have been rejected under 35 U.S.C. §102(b) as being anticipated by Cameron et al. (US 6,025,071).

The Examiner contends that Cameron describes a removable grade hot melt pressure sensitive adhesive and an adhesive article comprising a substrate and a removable and resealable adhesive (hot melt pressure sensitive adhesive) coated on the surface of the substrate (column 3, lines 29-32; column 7, lines 10-12). The adhesive comprises about 10-50% by weight of at least one styrene-isoprene-styrene block copolymer; about 10-40% by weight of at least one tackifying resin; and about 10-50% by weight of plasticizers (abstract). The copolymer component further may include about 0-30% by weight of the adhesive of a styrene-butadiene-styrene block copolymer (column 4, lines 28-45). The styrene-isoprene-styrene block copolymer comprises a mixture of triblock and diblock copolymers (column 3, lines 64-65), and the tackifying component includes a synthetic petroleum hydrocarbon resin having a softening point of 95°C (Wingtack 95) and tacifiers such as rosins, rosin esters and polyterpenes (column 5, lines 11-15, 37; column 6, lines 1-6). The Examiner also contends that since Cameron teaches the removal and resealable adhesive comprising the same chemical component as disclosed in the instant specification, Cameron's adhesives would inherently have the same properties such as the peeling force and cohesive strength. Cameron further teaches the substrate to be paper or polyester film, and the substrate can be one layer or multilayer (column 7, lines 21-51; column 8, lines 20-22, 42).

Reconsideration and withdrawal of the rejection of the above claims as anticipated by Sorensen is requested, particularly in view of the above amendments to the claims. All of the claims now specify that the adhesive article of the invention comprises (a) a moisture resistant substrate having a first and second surface, (b) a removable and resealable adhesive covering at least a portion of the first surface of the substrate, wherein the removable and resealable adhesive is removable and resealable in the presence of moisture from refrigerated or frozen food packaging environments, and the adhesive has a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. Although Cameron describes removable

hot melt rubber based pressure sensitive adhesives, there is no teaching or suggestion of the use of such adhesives or articles containing such adhesives in refrigerated or frozen food packaging environments, nor is there any teaching or suggestion of adhesives which are resealable in the presence of moisture at these low temperatures. Moreover, Cameron neither teaches nor suggest removable and resealable adhesives characterized as having a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C.

Although Cameron generally describes the use of rubber based pressure sensitive adhesives, there is no further discussion of the adhesives or further discussion of the Moist Loop Test results which are obtained with such adhesives, and thus, there is no basis for the Examiner's conclusion that the adhesives disclosed by Sorensen would "inherently" have the same Moist Loop Test result as presently claimed. Moreover, even though some of the adhesives included within the broad categories of rubber based pressure sensitive adhesives mentioned in Cameron may exhibit a Moist Loop Test result within the claimed range, such possibilities or probabilities do not support a rejection based on inherency, as discussed in more detail above with regard to the rejection based on Sorensen.

Reconsideration and withdrawal of the rejection of claim 18 also is requested. Claim 18 specifies that the adhesive article also comprises (c) at least one permanent adhesive covering a second portion of the first surface of the substrate. Applicant finds no teaching or suggestion in Cameron of an adhesive article which comprises a substrate having a removable adhesive covering a first portion of one side of the substrate and a permanent adhesive covering a second portion of the same surface of the substrate.

IV. Claims 12-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sorensen as applied to Claim 1 above, and further in view of Cameron et al. (US 6,025,071).

This rejection is now moot in view of the cancellation of claims 12-17.

V. Claims 4-7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sorensen as applied to claim 1 above and further in view of MacGregor.

Sorensen has been described above, and the Examiner acknowledges that Sorensen does not teach the substrate comprising a multilayer film, or that the substrate comprises a polymeric film as recited in the instant claims.

The Examiner contends that MacGregor teaches a substrate comprising a multilayer film such a paper coated with varnish or plastic films such as polystyrene, polyethylene or polypropylene (column 4, lines 17-24, 48-67). Therefore, the Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the substrate as a plastic film as taught by MacGregor, in the adhesive article of Sorensen.

Reconsideration and withdrawal of this rejection are requested since even if it would have been obvious to utilize multilayer films in Sorensen's articles based upon the teachings in MacGregor, the construction which results from this proposed combination is not the construction claimed in the present application. Rejected claims 4-7 (dependent from claim 1) specify that the adhesive article of the invention comprises (a) a moisture resistant substrate having a first and second surface, and (b) a removable and resealable adhesive covering at least a portion of the first surface of the substrate, wherein the removable and resealable adhesive is removable and resealable in the presence of moisture from refrigerated or frozen food packaging environments, and the adhesive has a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. Although Sorensen describes labels utilizing removable and resealable adhesives, there is no teaching or suggestion of the use of such adhesives in refrigerated or frozen food packaging environments, nor is there any teaching or suggestion of adhesives which are resealable in the presence of moisture at these low temperatures. In addition, Sorensen neither teaches nor suggests removable and resealable adhesives characterized as having a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C. Although as mentioned above, Sorensen discusses the peeling force of pressure sensitive adhesives and suggest that the removable

adhesives have peeling forces of about 0.7 lbs/in. and 0.9 lbs/in. The claims of the present application require adhesives having a Moist Loop Test result (which is different from peeling force measurements) of at least about 0.8 N/25mm at a test plate temperature of 5°C. Thus, even if it would be obvious to modify Sorensen by using multilayer films such as paper coated with varnish or plastic films such as polystyrene, polyethylene or polypropylene in view of MacGregor, the resulting combination would not be an adhesive construction as presently claimed.

Conclusion

In view of the above amendments and remarks, Applicant respectfully submits that all of the claims in the application are in condition for allowance. An early action allowing claims 1-11, 18-20 and 41-45 is requested.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **AVERP3447USA**.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By: Heidi A. Boehlefeld

Heidi A. Boehlefeld
Reg. No. 34,296

1621 Euclid Avenue
19th Floor
Cleveland, Ohio 44115-2191
(216) 621-1113